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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,941

09/22/2003

Andrew Walker

P-US-CS 1144

1634

7590

07/14/2005

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EXAMINER

KYLE, MICHAEL J

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,941

Applicant(s)

WALKER ET AL.

Examiner

Michael J. Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-5 are rejected under 35 U.S.C. 102(e) as being anticipate by DeLuca et al (“DeLuca”, U.S. Patent No. 6,591,456). With respect to claim 2, examiner notes that the limitation in the preamble, “for a power tool comprising a housing and a motor within the housing...” is an intended use recitation. As long the prior art is *capable* of being used for the intended purpose, then it is considered to read on the claim. DeLuca discloses a gripping portion, which is capable of being used with a power tool, where the gripping portion comprises at least one flexible sheet (100, 102, 202) and at least one support (230, 250, 256). The flexible sheet is mounted to the support to retain gaseous vibration damping medium (column 12, lines 20-21) between the support and a single thickness of the sheet. Examiner notes that layer 172 is single thickness. The gaseous medium (108) is retained between this and the support as claimed. Additionally, the support includes at least one aperture (254) enabling a portion of the flexible sheet (100, 102, 202) to protrude through the aperture.
3. With respect to claims 3-5, the flexible sheet has a plurality of pockets (106), and the support forms part of the housing (112, 114). The gaseous medium is air (column 12, line 29).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, 7, and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wadge (U.S. Patent No. 6,206,107) in view of DeLuca (U.S. Patent No. 6,591,456). With respect to claim 1, Wadge discloses a gripping portion (on handle 10) for a power tool. The gripping portion is engaged by the hand of a user of the tool. The power tool includes a housing (4) and a motor. Wadge fails to disclose the flexible member, clamping member, or chamber as claimed.

6. DeLuca discloses a gripping portion used on a tool, comprising at least one flexible member (100, 102, 202) and a clamping member (230, 250, 256) having an aperture (254) so that the clamping member clamps the flexible member to the housing (112, 114, 118). A gaseous vibration damping medium (column 12, lines 20-21) is retained between the flexible member and the housing. The flexible member protrudes through the aperture (column 8, lines 20-31), and substantially none of the vibration damping medium is located in use between the clamping member and the housing (with the arrangement shown in figure 2, column 9, lines 25-35). DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user.

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7. With respect to claims 6 and 7, Wadge discloses a power tool having a housing (4) with a handle (10) and a motor to actuate an output member of the tool. The handle includes a gripping portion (area to be gripped by user). Wadge fails to disclose the chamber enclosing a gaseous vibration damping medium, as claimed.

8. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21) extending outwardly from the gripping portion so that the gripping portion and the chamber may be simultaneously gripped. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca's arrangement further includes a cover piece (230, 250, 256) made of a material that is relatively hard as compared to the gaseous vibration damping medium. Examiner notes that any material will be relatively hard compared to a gas. The cover piece includes an aperture (254) through which the chamber protrudes.

9. With respect to claims 9-11, Wadge discloses a power drill (shown in figure 4) comprising a main body (4), a handle (10) having opposite side surfaces (6, 8) each defining gripping regions. Wadge fails to disclose the two chambers as claimed.

10. DeLuca teaches two chambers (106) enclosing a gaseous vibration damping medium, one chamber protruding outwardly from the gripping region of each opposite side surface. The chambers are discrete from each other. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at

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the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca also teaches four chambers.

11. With respect to claim 11, DeLuca discloses a single cover piece, but neither Wadge nor DeLuca show two cover pieces. However, replacing a single piece with multiple parts that act identical to the single piece is considered obvious and well known in the art. Such a change produces no new or unexpected result. It would have been obvious to one having ordinary skill in the art at the time of the invention to replace the single cover piece of DeLuca with a two cover pieces.

12. With respect to claims 12-14, Wadge discloses a power sander (column 5, line 1) comprising a housing with a main body (4) and upper gripping portion (on 10), a drive motor (22) in the main body, a sanding platen (sander attachment piece, not shown) extending downwardly from the main body and being driven by the drive motor. The handle (10) extends rearwardly from the main body. Wadge fails to disclose the chamber as claimed.

13. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21).

DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca also teaches four chambers. As a result of the combination, the chamber of DeLuca will protrude from an upper surface of the

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gripping portion of Wadge. DeLuca further shows two chambers enclosing the gaseous vibration damping medium.

14. With respect to claim 15, Wadge discloses a power saw (column 5, line 1, "jigsaw") comprising a main body (4) with an opening (18) therethrough to defines a handle (10) rearwardly of the opening, the housing adapted to receive a saw blade at a forward end. A motor (22) is disposed in the main body. The handle includes a gripping portion. Wadge fails to disclose the chamber as claimed.

15. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21) extending outwardly from the gripping portion so that the gripping portion and the chamber may be simultaneously gripped. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user.

Response to Arguments

16. Applicant's arguments filed April 21, 2005, have been fully considered but they are not persuasive.

17. With respect to claim 1, examiner notes this claim is now rejected based upon 35 U.S.C. 103(a). The new grounds of rejection were necessitated by applicant's amendment which positively claims a power tool.

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18. With respect to claim 2, examiner has changed the reference numerals of DeLuca that are cited in the rejection. The new interpretation of DeLuca was necessitated by applicant's amendment. Applicant argues that DeLuca fails to disclose a flexible sheet mounted on the support. Examiner respectfully disagrees. Examiner notes the claim requires the flexible sheet to be "mounted to the support". Examiner asserts that the portions of the flexible sheet extending through the support mount the flexible sheet to, and on, the support.

19. Applicant argues that no motivation or suggestion to combine the Wadge and DeLuca references. Applicant continues to state that DeLuca fails to disclose or suggest damping media. Examiner respectfully disagrees. Examiner notes that this argument appears to be directed toward the intended use of the media (as a "damping" media). The dependent claims of the instant application set for the damping media to be air. DeLuca provides a device that provides "a cushioning effect" (abstract) that uses air (column 12, line 29) along with the other structural features substantially as claimed. Because DeLuca's air is identical to applicant's claimed air, it follows that DeLuca's air is also capable of damping vibrations. Additionally, the fact that applicant has recognized another advantage (vibration damping) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

20. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the combination of Wadge and DeLuca disclose all of the claimed limitations. DeLuca provides a motivation for combining, in that DeLuca's grip provides a cushioning effect which lends to a comfortable, deformable grip, that conforms to a user's grip. As discussed in the preceding paragraph, the fact that applicant has recognized another advantage (vibration damping) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


ROBERT J. SANDY
PRIMARY EXAMINER